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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,963	12/03/2003	David Ernest Hartley	PA-5351-RFB	4386

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EXAMINER	
SEVERSON, RYAN J	
ART UNIT	PAPER NUMBER
3731	
MAIL DATE	DELIVERY MODE
02/24/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/726,963	**Applicant(s)** HARTLEY ET AL.	
	Examiner RYAN J. SEVERSON	**Art Unit** 3731	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 February 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *6,7,9 and 24*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Ryan J Severson/
Examiner, Art Unit 3731

Continuation of 11. does NOT place the application in condition for allowance because:

Examiner respectfully submits that all of the arguments presented after-final have been previously addressed in various office actions.

Applicant argues the cited Brightbill reference has been reviewed by the inventors and does not fall within the scope of the claimed invention. However, applicant provides absolutely no EVIDENCE to support this opinion.

Applicant states the device could not by itself or in combination could not be used for treatment of aortic dissection. Examiner notes this argument was already addressed in the non-final rejection of 7/7/2010. Examiner notes that this is merely intended use, and reminds applicant a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Examiner contends the device of Brightbill as modified in the previous rejections would be capable of performing the intended use. Absent EVIDENCE to the contrary, Examiner will maintain this position. Applicant is reminded that mere arguments can not take the place of evidence. In re Walters, 168 F.2d 79,80, 77 USPQ 609,610 (CCPA 1948); In re Cole, 326 F.2d. 769,773, 140 USPQ 230,233 (CCPA 1964); In re Schulze, 346 F.2d 600,602, 145 USPQ 716,718 (CCPA 1965); In re Lindner, 457 F.2d 506,508, 173 USPQ 356,358 (CCPA 1972); In re Pearson, 494 F.2d 1399,1405, 181 USPQ 641,646 (CCPA 1974); Meitzner v. Mindick, 549 F.2d 775,782, 193 USPQ 17,22 (CCPA), cert. Denied, 434 U.S. 854 (1977); In re DeBlauwe, 736 F.2d 699,705, 222 USPQ 191,196 (Fed. Cir. 1984).

Applicant argues Brightbill shows only one stent, not a plurality of stents. However, Examiner has considered each circumferential band of Brightbill to be a stent. In the combination set forth, each of these circumferential bands are separated by flexible links as taught by Cox et al. In Cox et al., multiple stents (114) are separated by flexible links (130). Therefore, the teachings of the prior art devices as a whole would suggest to a skilled artisan that the device can have a plurality of stents connected together by flexible links. Examiner notes here this rejection is drawn to replacing the fixed, rigid weld connections of Brightbill with flexible thread connections as taught by Cox et al. to enhance the flexibility of the prosthesis as a whole.

Applicant maintains their position that the Brightbill device does not disclose a graft material on a portion of the prosthesis leaving some stents covered and some stents uncovered. However, as asserted multiple times previously during prosecution (advisory action of 6/1/2010, final rejection of 12/22/2010 at paragraph 9), this is simply not the case. Examiner also notes with respect to Brightbill (as evidenced by the disclosure of Froix) that the disclosure is clear that the device of Brightbill can be sheath-wrapped over a portion of its length. Brightbill explicitly states in paragraph [0023] that the prosthesis can be a sheath-wrapped (graft-covered) prosthesis and that this wrap is to be over a portion of its length.

Examiner also notes applicant repeatedly refers to the prior-art devices being balloon expandable. Applicant has not acknowledged Examiners argument at paragraph 12 of the final rejection of 12/22/2010 that Brightbill explicitly discloses at paragraph [0044] that the prosthesis of the present invention can be self-expanding. Therefore, the idea that the claimed device is advantageous over the prior art devices because they are balloon expandable is simply not persuasive because the prior art explicitly recites the stents can be self-expanding.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Examiner also maintains that applicant has not shown any criticality for having 8-10 uncovered stents, and absent any criticality, Examiner will hold this limitation to have been obvious as set forth in the final rejection of 12/22/2010 and as described in detail in the non-final rejection mailed 7/7/2010 (at paragraphs 10 and 11). Examiner notes criticality is not the same thing as advantageous. Examiner can see how having 8-10 uncovered stents may have some perceived advantage. However, this does not mean that having exactly 8-10 stents is critical to the claimed invention. Effectively, if this claimed range were critical, that would mean a prosthesis having 7 or 11 uncovered stents (falling outside the claimed range) would not be effective in treating aortic dissection. There is no evidence provided to show that this would be the case. Examiner directs applicant's attention to MPEP 2144.05, which discusses obviousness of ranges, and MPEP 716.02(d)(II), which discusses how to establish criticality of claimed ranges.